

ESTTA Tracking number: **ESTTA744194**

Filing date: **05/04/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Vanderbilt Mortgage and Finance, Inc.		
Entity	Corporation	Citizenship	Tennessee
Address	500 Alcoa Trail Maryville, TN 37804 UNITED STATES		

Attorney information	Michael J. Bradford Luedeka Neely Group, P.C. P.O. Box 1871 Knoxville, TN 37901 UNITED STATES mbradford@luedeka.com, lprichard@luedeka.com Phone:865-546-4305
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Registrations Subject to Cancellation

Registration No	4678115	Registration date	01/27/2015
Registrant	Terra Holdings, LLC Suite 910 New York, NY 10065 UNITED STATES		

Goods/Services Subject to Cancellation

Class 036. First Use: 2004/05/00 First Use In Commerce: 2004/05/00 All goods and services in the class are cancelled, namely: Home appraisal services
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Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)		
Dilution by blurring	Trademark Act Sections 14(1) and 43(c)		
Registration No	4674773	Registration date	01/20/2015
Registrant	Terra Holdings, LLC 770 Lexington Ave New York, NY 10065 UNITED STATES		

Goods/Services Subject to Cancellation

Class 036. First Use: 2000/05/00 First Use In Commerce: 2000/05/00 All goods and services in the class are cancelled, namely: Insurance brokerage in the field of commercial and personal excess liability insurance

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)		
Dilution by blurring	Trademark Act Sections 14(1) and 43(c)		
Registration No	4678715	Registration date	01/27/2015
Registrant	Terra Holdings, LLC 770 Lexington Ave New York, NY 10065 UNITED STATES		


Goods/Services Subject to Cancellation

Class 036. First Use: 1999/00/00 First Use In Commerce: 1999/00/00
All goods and services in the class are cancelled, namely: Insurance brokerage in the field of home and property insurance

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
Dilution by blurring	Trademark Act Sections 14(1) and 43(c)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	2011510	Application Date	04/19/1995
Registration Date	10/29/1996	Foreign Priority Date	NONE
Word Mark	VANDERBILT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1977/06/00 First Use In Commerce: 1977/06/00 financing services for purchasers of manufactured homes		

Attachments	74663326#TMSN.png(bytes) 7120501-pleadings-20160504-petition_to_cancel.pdf(87128 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	s/Michael J Bradford/
Name	Michael J. Bradford
Date	05/04/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Service Mark

Registration Nos.: (1) 4,678,115
(2) 4,674,773
(3) 4,678,715

For the marks: (1) VANDERBILT APPRAISAL COMPANY
(2) VANDERBILT PROPERTIES INSURANCE
BROKERAGE
(3) VANDERBILT PROPERTIES INSURANCE
BROCKERAGE

Dates registered: (1) January 27, 2015
(2) January 20, 2015
(3) January 27, 2015

VANDERBILT MORTGAGE AND FINANCE, INC.)
)
Petitioner,)
v.)
)
TERRA HOLDINGS, LLC)
)
Respondent.)

PETITION FOR CANCELLATION

TRADEMARK TRIAL AND APPEAL BOARD

Commissioner for Trademarks

P.O. Box 1451

Alexandria, Virginia 22313-1451

Sir:

Petitioner, Vanderbilt Mortgage and Finance, Inc., believes it will be damaged by continued registration of the marks of the above-identified U.S. Registration Nos. 4,678,115, 4,674,773, and 4,678,715 to Respondent, Terra Holdings, LLC, for the services stated therein, and

hereby petitions to cancel the same upon at least the following grounds:

1. Petitioner, Vanderbilt Mortgage and Finance, Inc, (hereinafter, “Petitioner”) is a corporation of the State of Tennessee, and has a business address at 500 Alcoa Trail, Maryville, Tennessee 37804.

2. To the best of Petitioner's knowledge and belief, the current owner of record of the above-identified U.S. Service Mark Registration Nos. 4,678,115, 4,674,773, and 4,678,715 (collectively referred to herein at times as “Respondent’s Registrations”) for the marks VANDERBILT APPRAISAL COMPANY and VANDERBILT PROPERTIES INSURANCE BROKERAGE (collectively referred to herein at times as “Respondent’s Marks”) and the named Respondent herein is Terra Holdings, LLC, a limited liability company of the State of New York, with a mailing address at 770 Lexington Avenue, New York, New York 10065.

3. The VANDERBILT APPRAISAL COMPANY mark of U.S. Service Mark Registration No. 4,678,115 is registered in International Class 036 for use with “home appraisal services.” Respondent claims it first used the VANDERBILT APPRAISAL COMPANY mark of the ‘115 registration anywhere and in commerce for home appraisal services at least as early as May, 2004.

4. The VANDERBILT PROPERTIES INSURANCE BROKERAGE mark of U.S. Service Mark Registration No. 4,674,773 is registered in International Class 036 for use with “insurance brokerage in the field of commercial and personal excess liability insurance.” Respondent claims it first used the VANDERBILT PROPERTIES INSURANCE BROKERAGE mark of the ‘773 registration anywhere and in commerce for insurance brokerage in the field of commercial and personal excess liability insurance at least as early as May, 2000.

5. The VANDERBILT PROPERTIES INSURANCE BROKERAGE mark of U.S.

Service Mark Registration No. 4,678,715 is registered in International Class 036 for “insurance brokerage in the field of home and property insurance.” Respondent claims it first used the VANDERBILT PROPERTIES INSURANCE BROKERAGE mark of the ‘715 registration anywhere and in commerce for insurance brokerage in the field of home and property insurance at least as early as 1999.

6. Petitioner is the owner of the right to exclusive use of the marks VANDERBILT, VANDERBILT MORTGAGE AND FINANCE, and other marks containing the term “Vanderbilt” (hereinafter, “Petitioner’s Marks”) for and in connection with financing services for residential housing and property, servicing loans for third parties, and selling residential housing and property (hereinafter, “Petitioner’s Services”). Petitioner’s Marks include the mark VANDERBILT & Design of U.S. Registration No. 2,011,510 for use with “financing services for purchasers of manufactured homes” in International Class 036 (hereinafter, “the ‘510 Registration”), issued on October 29, 1996, by the United States Patent and Trademark Office on the Principal Register, based on use of the mark anywhere and in commerce beginning at least as early as June, 1977.

7. Petitioner’s Marks have been used substantially continuously in interstate commerce for and in connection with Petitioner’s Services since a date long before any date of actual or constructive first use of Respondent’s Marks anywhere and in commerce by Respondent or any licensee, affiliate, predecessor, or successor of Respondent.

8. Petitioner’s ‘510 Registration is valid, enforceable, subsisting, not abandoned, and Petitioner has the right to exclusive nationwide use of the mark thereof in commerce for and in connection with Petitioner’s Services.

9. Petitioner and its predecessors have expended considerable time, effort, and expense

in promoting, advertising, and making well-known among the purchasing public and the trade in general Petitioner's Services offered and provided under Petitioner's Marks in commerce in the United States, with the result that Petitioner has established valuable and exclusive rights and goodwill in the Petitioner's Marks as symbols of a source or origin of Petitioner's Services among the purchasing public and the trade in general in the United States.

10. By reason of the inherent distinctiveness and the extensive, intensive, and substantially continuous use, promotion, marketing, and advertisement thereof, Petitioner's Marks are and have become distinctive, well known, and famous in commerce in the United States, and became well known and famous in commerce in the United States among the purchasing public and the trade in general since a date long before the filing dates of the applications that led to issuance of Respondent's Registrations or any earlier use of the marks thereof by Respondent or any predecessor of Respondent.

11. Respondent's Services are highly related to Petitioner's Services offered under Petitioner's Marks for which Petitioner has actual and constructive priority of use. On information and belief, Respondent's Services are or will be offered and provided under Respondent's Marks through the same or related channels of trade and/or advertising media to the same or at least overlapping class of purchasers as Petitioner's Services offered and provided under Petitioner's Marks.

12. Petitioner has priority of use anywhere and in commerce of Petitioner's Marks for and in connection with Petitioner's Services in relation to any actual or constructive use of the Respondent's Marks of Respondent's Registrations for Respondent's services, such priority including, but not limited to, the earlier and substantially continuous actual and constructive use of Petitioner's Marks in commerce in the United States for and in connection with Petitioner's Services prior to the filing dates of the applications which led to the issuance of Respondent's

Registrations or any earlier date of first use of Respondent's Marks claimed in Respondent's Registrations.

13. Pursuant to 15 U.S.C. § 1057(b), Petitioner has the right to exclusive use of Petitioner's Mark shown in its '510 registration for and in connection with the goods specified in Petitioner's '510 Registration and the issuance of Respondent's Registrations for the services stated are and were in conflict with and/or in derogation of such exclusive rights of Petitioner.

14. Use of Respondent's Marks of Respondent's Registrations for the services stated therein is likely to cause confusion, mistake or deception as to the source of the services thereof because of the confusing similarity of Respondent's Marks and Petitioner's Marks. Therefore, continued existence of Respondent's Registrations on the Principal Register and the rights, privileges, and benefits appurtenant thereto damages Petitioner, the common law rights in Petitioner's Marks, and the rights, presumptions, privileges, and benefits appurtenant to Petitioner's '510 Registration, and the Respondent's Registrations should therefore be cancelled under at least 15 U.S.C. § 1064.

15. The Trademark Office has previously determined on multiple occasions that Petitioner's Marks and Respondent's Marks, or marks substantially similar thereto, are confusingly similar.

16. Respondent filed U.S. Application Serial No. 76/302,815 (the "'815 application") on August 6, 2001, seeking to register VANDERBILT PROPERTIES INSURANCE for use with "Insurance brokerage services in the field of luxury residential properties and commercial properties, directors' and officers' ('D and O') insurance, and commercial general liability and umbrella insurance." Respondent's '815 application was rejected by the U.S. Patent and Trademark Office based on a determination that the mark of the '815 application was confusingly

similar to the mark of Petitioner's '510 registration. The '815 application was subsequently abandoned by Respondent.

17. Respondent filed U.S. Application Serial No. 76/288,429 (the "'429 application") on July 18, 2001, seeking to register VANDERBILT FINANCIAL SERVICES for use with "Mortgage brokerage services for purchasers of luxury residential properties." Respondent's '429 application was rejected by the U.S. Patent and Trademark Office based on a determination that the mark of the '429 application was confusingly similar to the mark of Petitioner's '510 registration. The '429 application was subsequently abandoned by Respondent.

18. Petitioner filed U.S. Application Serial No. 86/432,240 (the "'240 application") on October 23, 2014, seeking to register VANDERBILT EXPRESS & Design for use with "Providing internet based data capture services that enable the exchange of information via the internet from residential mortgage borrowers to institutions for use in loan workouts; Online loan services." Petitioner's '240 application was rejected by the U.S. Patent and Trademark Office based on a determination that the mark of the '240 application was confusingly similar to Respondent's Marks of Respondent's Registrations. As such, Respondent's Registrations are a source of damage to Petitioner in that they are blocking Petitioner from obtaining additional registrations for Petitioner's previously used Marks. For reasons unrelated to the rejection based on Respondent's Marks, the '240 application was abandoned by Petitioner following the rejection.

19. Respondent's Registrations for Respondent's Marks are also a source of damage to Petitioner as the marks Respondent registered dilute the distinctive quality of Petitioner's previously used famous Marks to the detriment of Petitioner and its rights. Respondent's Registrations should, therefore, be cancelled at least under 15 U.S.C. §§ 1052, 1063, and 1125.

WHEREFORE, Petitioner urges and prays that this Honorable Board, upon consideration of the grounds set forth herein, determine that Petitioner has made out a good and sufficient basis to determine that Petitioner is being damaged by continued registration of Respondent's Marks of Respondent's Registrations, and that the same be cancelled.

A fee in the amount of \$900.00 as required by the Commissioner for Trademarks is filed herewith for petitions for cancellation of three registrations, each covering one class. The commissioner is authorized to draw on the Deposit Account of Luedeka Neely Group, P.C., Account No. 12-2355, if the payment is insufficient or inadvertently omitted.

Respectfully submitted,

s/Michael J. Bradford/
Michael J. Bradford (Reg. No. 52,646)
LUEDEKA NEELY GROUP, P.C.
Attorneys for Petitioner
P.O. Box 1871
Knoxville, TN 37901
(865) 546-4305

Certificate of Service

This is to certify that a true and correct copy of the foregoing is being served on Respondent and Respondent's counsel of record, by first class mail, postage prepaid, addressed as follows:

Terra Holdings, LLC
770 Lexington Avenue
New York, NY 10065

and

Joseph Stofer, Esq.
Sofer & Haroun, LLP
215 Lexington Ave., Suite 1301
New York, NY 10016

Date: May 4, 2016

s/Michael J. Bradford
Michael J. Bradford